

Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The final Office Action dated June 24, 2004, indicated that claims 6-8 are rejected under 35 U.S.C. § 102(b) over *Williams et al.* (U.S. Patent No. 5,218,228); and claim 9 is rejected under 35 U.S.C. § 103(a) over *Williams et al.* in view of *Blanchard* (U.S. Patent No. 4,345,265).

The instant Office Action merely repeats the previous rejections without addressing Applicant's arguments against them. The MPEP dictates that the Office Action should take note of the applicant's arguments and answer the substance of them. *See* MPEP § 707.07(f). This is consistent with the purpose of aiding the applicant in judging the propriety of continuing the prosecution, as indicated in 37 C.F.R. § 1.104(a)(2) and 35 U.S.C. § 132. MPEP § 707.07(f) further urges that the Examiner state the reasons for his or her position (regarding Applicant's arguments) in the record. The Office Action fails to address any of Applicant's arguments regarding the failure of the '228 reference to correspond to the claimed invention. Because the Office Action fails to comply with this requirement, Applicant requests that the rejection and its finality be withdrawn.

As discussed and addressed in connection with the previous Office Action Response filed on April 28, 2004, the prior art rejections are improper because the Office Action fails to indicate how the cited references correspond to the claimed invention. Because of this apparent lack of correspondence, Applicant submitted that the '228 reference was unrelated to the claimed invention. In reply, the Office Action asserts that the '228 reference is analogous to the claimed invention because it teaches a method to form a bipolar transistor and cites *In re Oetiker*. The cited case addressed a rejection relying on art from an area other than that of the claimed invention, *e.g.*, combining teachings directed to a hose clamp with teachings directed to a garment fastener, and held that the combination was insufficient to support a *prima facie* case of obviousness. *In re Oetiker* is inapplicable to the instant rejections (primarily under Section 102(b)) because regardless of the '228 reference's area of art, the reference fails to correspond to the

claimed invention. The Office Action still fails to identify any teachings that allegedly correspond to the claimed limitations. The Office Action's failure to address Applicant's arguments and reliance on unrelated case law fail to support a *prima facie* case of rejection, therefore, the rejections and the finality of the instant Office Action should be withdrawn.

Applicant respectfully maintains the traversal of the Section 102(b) and Section 103(a) rejections because the Office Action fails to show correspondence between each of the claimed limitations and the cited '228 reference. Specifically, the Office Action fails to identify where and how various aspects of the claimed first, second, and third semiconductor regions correspond to the '228 reference, and where these limitations are taught in the '228 reference, *e.g.*, relative to the claimed "partial region with a smaller flux of dopant atoms" in the second semiconductor region. With particular respect to claims 7 and 8, the Office Action fails to identify correspondence to the claim limitations involving a partial region that has a smaller thickness than the remainder of the region as claimed. With or without the rationale provided in the Office Action, the '228 discussion of figure 6 does not appear to include any teachings that would correspond to the claimed invention. Without a presentation of correspondence to each of the claimed limitations, the Office Action fails to present a *prima facie* case of rejection and the rejections cannot be maintained.

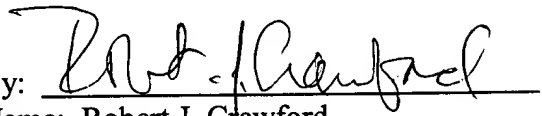
Accordingly, Applicant fails to recognize a correlation between the instant invention and the '228 reference and the Office Action fails to provide a presentation of prior-art correspondence to each of the claimed limitations; therefore, the Section 102(b) and Section 103(a) rejections cannot stand. Because the instant Office Action has failed to address these previously-presented arguments, the Office Action also fails to comply with MPEP § 707.07(f) and the finality of the Office Action is inappropriate. Applicant accordingly requests that the rejections be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Mr. Peter Zawilski, of Philips Corporation at (408) 474-9063.

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